



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,847	08/25/2006	Kyuhei Kitao	3273-0227PUS1	3804
2292 7590 11/26/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MCCULLEY, MEGAN CASSANDRA				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
11/26/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

***Response to Arguments***

The amendments to the claims will not be entered because the scope of the claims is changed; new issues are raised which would require a further search and/or consideration. The specific issues raised are the narrowing of the percarboxylic acid to peracetic acid and including a solvent which is ethyl acetate solution as well as narrowing the distillation temperature range to 180-350 °C.

While arguments to the not entered amendments will not be addressed below, applicant's arguments pertaining to the finally rejected claims will be discussed for further clarification.

Applicant's arguments filed November 7, 2008 have been fully considered but they are not persuasive, because:

A) In response to applicant's argument that the limitations of concentration of high molecular weight components and color hue of the instant claims is not met by Takai '618, the instant claims are directed to a compound and a process of making that compound, not to a composition. The concentration of high molecular weight components and the color hue appear to be directed to a composition in which the claimed compound is in, not directed to the compound. Since a compound is claimed and that compound is disclosed in the prior art, the properties of that compound are inherent in the prior art teaching or there are essential and critical elements missing from the instant claims that would produce a compound with those properties.

B) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Takai '618 and Boehme et al. are analogous art because they are both concerned with the same field of endeavor, namely preparing cycloaliphatic diepoxides from the corresponding diolefin with a percarboxylic acid in solvent.

C) Applicant's argument that Boehme et al. uses a different linking group than the instant invention is not persuasive. Boehme et al. is the secondary reference and is relied on for the distillation step, not the compound. Takai '618 teaches the claimed compound. If Boehme et al. taught the compound as claimed, the rejection would be based on §102 instead of §103.

D) In response to applicant's argument that the double patenting rejection to application number 10/883162 should be removed, it has not been removed since the composition claimed in claim 5 of the copending application completely encompasses the compound claimed in claims 1-3 of the instant application; that is, to have the composition of the copending application, one also has the compound of the instant invention.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan McCulley whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/M. M./  
Examiner, Art Unit 1796